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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,834

11/24/2003

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4796

37476 7590 08/18/2008
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EXAMINER

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ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

08/18/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/719,834
Filing Date: November 24, 2003
Appellant(s): EASTMAN, MICHAEL ANTHONY

Matthew T. Welker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/20/2007 appealing from the Office action mailed 9/1/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,211,281	SPESHYOCK ET AL	10-1965
2,650,597	GIRARD	9-1953
1,655,452	AMENT	1-1928
3,822,780	ULMER ET AL	7-1974
D358,477	DE MEO	5-1995
5,433,314	LIN	7-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9, 12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "said reflective surface is secured within the basin by embedding means toward the center of the depth of said basin against the depth of said reflective surface" and "the securing means..., are the compression forces created by the depth of said basin..., said reflective surface has a

slightly larger diameter than said basin" had no support in the original specification. The specification only disclosed adhering or embedding the reflective surface into the closure cap. The adhesion or the step of embedding does not necessarily require any compression force toward center of the basin. The reflective surface can simply be enclosed firmly into the basin by glue or other means and need not require embedding means toward the center of the depth of the basin. In addition, the specification never disclosed that the reflective surface has a larger diameter than the basin.

Claim 9, 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 9, "the reflective surface is secured within said basin toward the center of the depth of said basin", in claim 12, the phrase "said reflective surface is secured within the basin by embedding means toward the center of the depth of said basin against the depth of said reflective surface" and in claim 14, "the securing means...are the compression forces created by the depth of said basin...", said reflective surface has a slightly larger diameter than said basin is not definite because it is not clear what embedding means or compression forces is exerted toward center of the depth of the basin.

Claims 1 and 4 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Speshyock et al. (US 3,211,281). Speshyock et al. discloses a contact lens case comprising a base 1 and a cover 2. At least one reservoir or the receptacle compartment on the top side of the base and having an outer surface. A reflective surface 5 covering for the outer surface of the cover and having a reflective outer

surface. The cover has a basin and the reflective surface has a depth less than the basin depth. The depth of the basin is from the top surface of the cover to element 5'. The mirror is the thin piece within the basin as shown in Figure 3.

Claim 6 is finally rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Speshyock et al in view of Girard (US 2,650,597) or Ament (US 1,655,452). Speshyock has a basin for receiving the mirror. The mirror appears to be attached to the basin, but in the event that it is not attached, it would have been obvious to secure the mirror to prevent it from inadvertent removal from the basin. Girard and Ament show this type of attachment. Girard teaches providing a mirror on the cap portion with the mirror embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. Ament also teaches a cap 3, 4 with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9.

Claims 1-14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ulmer et al. (US 3,822,780) in view of Girard and/or Ament. Ulmer et al. discloses a contact lens case for storing contact lenses comprising a base 18 having a top side. A least one reservoir on the top side of the base and having an outer surface with threads. A cap 14 for the reservoir and is attached to the outer surface of the reservoir by threads. A reflective surface covering 60 is on the outer surface of the cap. Ulmer on column 5, lines 35-38 discussed the adoption of the mirror on a portion of the outside surface of the container but does not disclose how the mirror is formed on the outer surface. However, Girard teaches providing a mirror on a cap portion with the mirror

embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. Ament also teaches a cap 3,4 with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9. The mirror is spun or crimped or suitably secured to the cap. Therefore, it would have been obvious in view of Girard and/or Ament to secure the mirror within the basin by any suitable attachment means such by embedding or crimping the mirror therein.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament. De Meo discloses a contact lens case for storing contact lenses comprising a base having a top side. At least one reservoir on the top side of the base and having an outer surface. A cap for the reservoir is attached to the outer surface of the reservoir. De Meo appears to have a reflective surface on the cap. But in the event that De Meo does not have a reflective surface and a basin, Girard teaches providing a mirror on a cap portion with the mirror embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. The mirror is for application of content. Ament also teaches a cap 3,4 with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9. The mirror is spun or crimped or suitably secured to the cap. Therefore, it would have been obvious in view of Girard and/or Ament to secure the mirror within the cap by any suitable attachment means such by embedding or crimping the mirror therein.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1 above, further in view of Lin (US)

De Meo does not disclose whether the base and cap are engaged by threads. However, it is conventionally known to engage the cap to the base of a contact lens container by threads. This is shown by Lin as element 102,202.

Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament and Lin. De Meo discloses a contact lens case for storing contact lenses comprising a base having a top side. At least one reservoir on the top side of the base and having an outer surface. A cap for the reservoir is attached to the outer surface of the reservoir. De Meo appears to have a reflective surface on the cap. But in the event that De Meo does not have a reflective surface and a basin, Girard teaches providing a mirror on a cap portion with the mirror embedded within a basin. The basin has a depth deeper than the mirror in order to receive the mirror. The mirror is for application of content. Ament also teaches a cap 3,4 with a basin that stores a mirror 5 therein. The basin is the area from the top surface to the element 9. The mirror is spun or crimped or suitably secured to the cap. Therefore, it would have been obvious in view of Girard and/or Ament to secure the mirror within the cap by any suitable attachment means such by embedding or crimping the mirror therein. De Meo does not disclose whether the base and cap are engaged by threads. However, it is conventionally known to engage the cap to the base. This is shown by Lin as element 102,202.

(10) Response to Argument

Applicant's arguments filed 11/20/2007 have been fully considered but they are not persuasive. Regarding applicant's arguments toward the 35 USC 112, first and second paragraph rejections: Applicant is incorrect in arguing that compressive forces are inherently included in the process of embedding. The term 'embed' is defined as "to fix into a surrounding mass" (dictionary.com), no compressive force is necessary.

Applicant argues that the cover in Speshyock et al. does not meet the cover as claimed because the mirrored cover of the instant invention has threads to connect to the base. However, claim 1 does not require this feature as argued. Applicant further argues that the mirrored case holds a contact lens case and is not a mirrored contact lens case by itself. The examiner fully appreciates the difference pointed out by applicant. However, applicant has not made this differentiation in the claim. The structural language in the claim requires a cap and a base. The cap has a basin and a reflective surface covering on an outer surface. The reflective surface covering has a depth less than the depth of the basin. Speshyock's cover 2 and base 1 have met all of the claim limitations in claim 1. In other words, there is no difference in the claim language between the cover of the applied reference and the claim even with elements 9 in the applied reference.

Further regarding applicant's argument that Speshyock does not disclose the basin wherein the reflective surface has a depth less than the basin depth" this is clearly shown in Fig. 3. The depth of the basin is from the top surface of the cover to element 5'. The depth of reflective surface 5 is clearly less than the depth of the basin.

Applicant argues that the examiner has made no effort to cite a suggestion to combine the mirrored caps taught by the secondary references. However, applicant proceeds to state that the examiner alleges that it would be "obvious to secure the mirror to prevent it from inadvertent removal." It is clear from this statement that applicant acknowledges that the examiner did make a suggestion or motivation to combine the references. Hence, the two statements are contrary to one another. In addition, applicant argues that the examiner cannot claim it is obvious to attach the mirror to the cap because Speshyock may desire removal of the mirror. However, for a rejection based on prima facie case of obviousness, the examiner only has to show some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited reference or prior art specifically suggest making the combination. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In addition, the reference itself does not prohibit the attachment to the basin.

Applicant argues that the examiner has misinterpreted the Ulmer reference because it is the container 14 that has the mirrored surface, not the cap 18. However, the examiner has interpreted element 14 as the cap and element 18 as the base. It is within the discretion of the examiner to interchange the terms "container" and "cap" as long as the structure fits the term. Hence, the cap 14 has the mirrored surface as required by the claim.

Applicant argues that the examiner cannot claim it is obvious to attach the mirror to the cap because the lack of teaching and Ulmer et al. may desire removal of the

mirror. However, for a rejection based on prima facie case of obviousness, the examiner only has to show some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited reference or prior art specifically suggest making the combination. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In addition, the reference itself does not prohibit the attachment to the basin.

Applicant argues that Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by Girard and Ament for use on a contact lens case, such as that of De Meo. However, Girard teaches providing a mirror on a cap portion with the mirror embedded within a basin for the purpose of allowing the user to use the mirror; and Ament also teaches a cap 3, 4 with a basin that stores a mirror 5 therein for allowing the user to use the mirror. Therefore, it would have been obvious in view of Girard and/or Ament to secure the mirror within the cap by any suitable attachment means such by embedding or crimping the mirror therein for holding a mirror for use by the consumer.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Steven A. Reynolds/
Patent Examiner AU 3728
8/7/2008

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/Mickey Yu/
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